

REMARKS

Applicant respectfully requests reconsideration of the present U.S. Patent application. Claims 1, 6, 11 and 16 have been amended. No claims have been canceled or added. Thus, claims 1-20 remain pending.

Drawings

Objections to the drawings will be eliminated with separately filed proposed drawing changes.

Claim Rejections - 35 U.S.C. § 102

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4,835,372 issued to Gombrich et al. (*Gombrich*). For at least the reasons set forth below, Applicant submits that claims 1-20 are not clearly anticipated by *Gombrich*.

In an Office Action mailed November 6, 2001 (the First Office Action), the Examiner states "Claims 1-20 rejected under 35 USC 102(b) as being clearly anticipated by [*Gombrich*]." In response to the First Office Action, Applicant cited 35 U.S.C. § 132, which requires that an examiner include in the action reasons for any rejection, objection or requirement. Applicant respectfully requested that the Examiner explicitly specify, for each rejected claim, where each and every element of the claim was taught or suggested by the cited reference.

The only reference to the “clearly anticipated” standard found by the Applicant in the MPEP appears in MPEP Section 706.02(i). MPEP Section 706.02(i) states that

The following form paragraphs should be used in making the appropriate rejections.

Note that the particular part of the reference relied upon to support the rejection should be identified.

(emphasis added). Paragraph 7.15 (“Claims [1] rejected under 35 U.S.C. 102[2] as being [3] by [4]”) appears to be the form paragraph the Examiner used in rejecting Claims 1-20 in the First Office Action. The Examiner Note for Paragraph 7.15 states “in bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph” (emphasis added). In the First Office Action, the Examiner neither identified the particular part of the reference relied upon to support the rejection nor provided an explanation of why the claims were clearly anticipated by *Gombrich*.

In the Office Action mailed February 15, 2002 (the Second Office Action), the Examiner identified the particular part of *Gombrich* relied upon to support the rejection of Claim 1 only. Specifically, the Examiner stated that “a reference which clearly anticipates the claims needs no further explanation” (emphasis in original). The Examiner then stated that “as a courtesy and consideration to the applicant, a mapping of claim 1 onto [*Gombrich*] is provided below. The remaining claims [2-20] can be similarly mapped onto [*Gombrich*].”

Amended Claim 1 recites the following:

providing access to a set of products available for electronic ordering by a user;
monitoring products ordered by the user; and
providing, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user.

Amended Claim 11 is an apparatus claim written in means-plus-function language, and recites similar limitations.

Gombrich discloses a physician writing a prescription for a patient, a secretary or other staff person accessing from a terminal a list of drugs in a computer system after scanning the patient's identification bar code, and entering drug dosages. See col. 14, lines 40-47. The staff person places a patient identification bar code label on the prescription and sends the prescription to the pharmacy for filling. See col. 14, lines 61-64. A pharmacist scans a patient's identification bar code to access the patient's file at the pharmacy terminal and checks the computer's prescription data against the prescription. See col. 14, line 65 – col. 15, line 1. In addition, a computer system records a drug or other item dispensed to a patient in the patient's billing file, which is accessible from a terminal in the billing department. See col. 17, lines 31-36. *Gombrich* thus discloses a first person entering drug dosages in a list of drugs and a different person later accessing the drug-related information. *Gombrich* does not disclose providing, automatically, in response to subsequent accesses by a user a list of products previously ordered by the user. Therefore, *Gombrich* does not clearly anticipate the invention as claimed in claims 1 and 11.

Claims 2-5 depend from claim 1. Claims 12-15 depend from claim 11. Because dependent claims include the limitations of the claims from which they depend, Applicant submits that claims 2-5 and 12-15 are not anticipated by *Gombrich* for at least the reasons set forth above.

35 U.S.C. § 132, cited previously, requires that an examiner include in the action reasons for any rejection, objection or requirement. A claim rejection violates 35 U.S.C.

§ 132 if it “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990). Applicant submits that the rejection of claims 2-20 as being anticipated by *Gombrich* is uninformative and incomplete. Therefore, Applicant cannot provide a specific response to the rejections. For this reason, Applicant requests that the rejection of claims 2-20 as being anticipated by *Gombrich* be withdrawn or provided with more specificity in a non-final office action.

Furthermore, MPEP § 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 4 is a dependent claim that recites the following:

The method of claim 3 wherein reordering the product further comprises:
determining a location to which the product was previously shipped;
verifying the location; and
causing the reordered product to be shipped to the location.

Applicant is unable to locate in *Gombrich* any disclosure of causing a reordered product to be shipped.

Amended Claim 6 recites the following:

A machine-readable medium having instructions stored thereon to implement an electronic commerce World Wide Web page, the sequences of instructions, when executed by one or more processors, cause one or more electronic systems to:
provide access to a set of products available for electronic ordering by a user;
monitor products ordered by the user; and
provide, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user.

Applicant is unable to locate in *Gombrich* any disclosure of an electronic commerce World Wide Web page.

Amended Claim 16 recites the following:

A networked server device to provide information related to products available for ordering by a user of a client device coupled to the server, the server device to monitor products ordered by users that access the server device and to record products ordered by the users, wherein the server device provides one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.

As discussed above in connection with Claims 1 and 11, *Gombrich* does not disclose a server device providing one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.

Examiner has failed to explicitly show that each and every element as set forth in each of the rejected claims is taught or suggested by the cited reference. Thus, a *prima facie* case for rejection under U.S.C. § 102 (b) has not been made. In addition, at least claims 4, 6 and 16 cannot be mapped to *Gombrich*, as Examiner contends. Accordingly, the Examiner neither identified the particular part of the *Gombrich* relied upon to support the rejections nor provided an explanation of why the claims were clearly anticipated by *Gombrich*, which, as explained above, is required in connection with the clearly anticipated standard.

Finally, the Examiner made the Second Office Action final. As a result, the Examiner's failure in the First Office Action to identify the particular part of *Gombrich* relied upon to support the rejections or provide an explanation of why the claims were clearly anticipated by *Gombrich*, precluded the Applicant from having any arguments upon which to base an appeal. Specifically, Applicant did not have any basis upon which

to respond to the rejections of Claims 1-20 in the First Office Action. Therefore, rather than responding to the rejections, Applicant respectfully requested that the Examiner explicitly specify where each element of the rejected claims was taught or suggested by the cited reference. Because the Examiner made the Second Office Action final after failing to provide specific rejections in the First Office Action, Appellants are left to suspect that the Examiner is merely attempting to prejudice the Applicant by delaying the prosecution.

CONCLUSION


For at least the foregoing reasons, Applicant submits that the Examiner's rejections have been overcome. Therefore, claims 1-20 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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VERSION OF CLAIMS MARKED TO SHOW CHANGES

1. (Amended) A method comprising:

providing access to a set of products available for electronic ordering by a user;

monitoring products ordered by [a] the user; and

providing, automatically, [to the user access to] in response to subsequent

accesses by the user a list of products previously ordered by the user.

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6. (Amended) A machine-readable medium having instructions stored thereon to

implement an electronic commerce World Wide Web page, the sequences of instructions,

when executed by one or more processors, cause one or more electronic systems to:

provide access to a set of products available for electronic ordering by a user;

monitor products ordered by [a] the user; and

provide, automatically, [to the user access to] in response to subsequent accesses

by the user a list of products previously ordered by the user.

11. (Amended) An apparatus comprising:

means for providing access to a set of products available for electronic ordering

by a user;

means for monitoring products ordered by [a] the user; and

means for providing, automatically, [to the user access to] in response to

subsequent accesses by the user a list of products previously ordered by the user.

16. (Amended) A networked server device [comprising] to provide information related to products available for ordering by a user of a client device coupled to the server, the server device to monitor products ordered by users that access the server device and to record products ordered by the users, wherein the server device provides one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users.